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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/408,265	09/29/1999	ETSUKO KIMURA	Q55939	3838
7590	03/11/2004		EXAMINER	SING, SIMON P
SUGHRUE MION ZINN MACPEAK & SEAS 2100 PENNSYLVANIA AVENUE NW WASHINGTON, DC 200373202			ART UNIT	PAPER NUMBER
			2645	
DATE MAILED: 03/11/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/408,265	KIMURA, ETSUKO
Examiner	Art Unit	
Simon Sing	2645	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 22 December 2003.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-10 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date: _____
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>15</u>	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

## DETAILED ACTION

### ***Response to Arguments***

1. Applicant's arguments filed on 07/11/2003 regarding claims 1-10 (rejected by Palatsi) and 3-10 (rejected by Anderson) have been fully considered but they are not persuasive.

1.1 Applicant argues in the Remark (page 2, paragraph 1) that Palatsi does teach the limitation of: "items selected by the user being displayed hierarchically and at the same time (claim 1)" and "operation items being displayed hierarchically and at the same time (claim 3)". Examiner disagrees since Palatsi teaches displaying operation items of "lights" and "on" hierarchically and at the same time in figure 4, step 29. The applicant points out that at step 26, only "on" and "off" are displayed, and which are not hierarchically ("on" and "off" are parallel operations). However, in step 26, "on" and "off" are not selected items, but operating items waiting to be selected. Once selected, "on" is displayed with "lights" hierarchically and at the same time at step 29.

1.2 Applicant argues that Anderson does not teach displaying operation items hierarchically and at the same time in the Remark (last paragraph of page 2, and page 3). However, Anderson teaches in figure 9, step 510 that operation steps such as VM (voicemail) and NEW (new messages) are displayed hierarchically and at the same time since new messages are under voicemail; although operation item "OUT" has no

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relation with voicemail, but the applicant does not claim “all operation items are displayed hierarchically and at the same time”. Therefore Anderson teaches the limitation of claim 3 (and its dependent claims).

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Palatsi US Patent No. 5,892,475.

2.1 Regarding claim 1, Palatsi discloses a portable electronic device in figures 1-4, comprising:

a plurality of soft keys 11 and 12 associated one-to-one with a plurality of guide areas 13 and 14, included in a display area 8 (column 2, lines 25-27, 34-39); and

Control means for displaying, in each operation step, particular items (such as on or off of step 26 in figure 4) which can be selected by a user, and processing related operation in the guide area when one of said plurality of soft keys is pressed (column 2, lines 52-59), wherein operation items (lights and on) selected by a user are displayed hierarchically and at the same time (Figure 4, step 29).

2.2 Regarding claim 2, the portable electronic device of Palatsi is a handy phone (column 2, lines 18-30).

2.3 Regarding claim 3, Palaski discloses a portable electronic device in figures 1-4, comprising:

storing means [memory 6] for storing a plurality of functions which can be selected by a user (column 2, lines 21-24, 57-59);

a display 8 including a plurality of guide areas each for display respective guidance information representative of an operation item which can be selected by the user (column 2, lines 25-27, 52-59);

a key input section a plurality of soft keys 11 and 12 associated one-to-one with a plurality of guide areas 13 and 14, included in a display area 8 (column 2, lines 25-27, 34-39); and

control means for processing related operation in the guide area when one of said plurality of soft keys is pressed (column 2, lines 52-59), wherein operation items, such as "lights" and "on", are displayed hierarchically and at the same time (Figure 4, step 29).

2.4 regarding claim 4, Palatsi discloses that the guide areas comprise a plurality of areas formed by dividing one of a plurality of display lines included in said display, said soft keys are being positioned in the vicinity of said display in a same arrangement as said guide areas (figures 2-4; column 2, lines 25-27, 34-39).

2.5 Regarding claim 5, Palatsi discloses that the guide areas comprise character sequence representative of the operation items which can be selected by the user (column 2, lines 52-59).

2.6 Regarding claim 6, the portable electronic device of Palatsi is a handy phone (column 2, lines 18-30).

2.7 Regarding claim 7, Palatsi discloses that the guidance information comprises marks appearing on another display line of said display areas for designating values of set statuses in a form of the operation items which can be selected by the user (column 2, lines 60-67; column 3, lines 1-15).

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2.8 Regarding claims 8-10, Palatsi's device is a portable telephone (column 2, lines 18-30).

3. Claims 3-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Anderson et al. US Patent No. 5,737,394.

3.1 Regarding claim 3, Anderson discloses a portable electronic device in figures 2-10, comprising:

storing means [memory 52, figure 3] for storing a plurality of functions which can be selected by a user (column 7, lines 17-35);

a display 18 including a plurality of guide areas each for display respective guidance information representative of an operation item which can be selected by the user (column 5, lines 18-21, 50-64);

a key input section a plurality of soft keys 20 associated one-to-one with a plurality of guide areas 64 included in a display area 18 (column 4, lines 3-8; column 5, lines 18-21);

control means for processing related operation in the guide area when one of said plurality of soft keys is pressed (column 5, lines 39-64; column 11, lines 32-39; column 12, lines 8-19); and wherein

operation items are displayed hierarchically and at the same time, such as in figure 9A, Step 510, operating items such as "VM" and "NEW" are displayed hierarchically (new voice messages are under voicemail).

3.2 regarding claim 4, Anderson discloses that the guide areas comprise a plurality of areas formed by dividing one of a plurality of display lines included in said display, said soft keys are being positioned in the vicinity of said display in a same arrangement as said guide areas (figure 2B; figure 4; column 4, lines 3-8).

3.3 Regarding claim 5, Anderson discloses that the guide areas comprise character sequence representative of the operation items which can be selected by the user (column 5, lines 18-21; column 7, lines 32-39; column 12, lines 8-19).

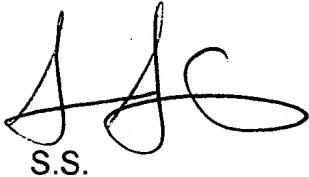
3.4 Regarding claim 7, Anderson discloses that the guidance information comprises marks appearing on another display line of said display areas for designating values of set statuses in a form of the operation items which can be selected by the user (column 12, lines 8-19).

3.5 Regarding claims 6 and 8-10, Anderson's device is a portable telephone (figure 2; column 3, lines 52-58).

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***Conclusion***

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Simon Sing whose telephone number is (703) 305-3221. The examiner can normally be reached on Monday - Friday from 8:30 AM to 5:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang, can be reached at (703) 305-4895. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4750.



S.S.

Allan Hoosain  
ALLAN HOOSAIN  
PRIMARY EXAMINER for  
Fan Tsang

03/05/2004